

REMARKS/ARGUMENTS

Favorable reconsideration of this application as presently amended and in light of the following discussion is respectfully requested.

Claims 1-20 are pending in this application. Claims 19 and 20 are withdrawn. Claims 1-17 and 20 are amended by the present amendment. No new matter is added.

In the outstanding Official Action, Claims 3, 9-11, 13-15, and 17 were objected to; Claims 1-18 were rejected under 35 U.S.C. §112, second paragraph; Claims 1-5 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as unpatentable over Claim 4 of U.S. Patent Application No. 10/426,657; and Claims 1, 2, 6, and 7 were rejected under 35 U.S.C. §102(e) as anticipated by Coteet et al. (U.S. Patent No. 6,671,839, hereinafter "Coteet"); Claims 4, 5, 9-11, and 14 were rejected under 35 U.S.C. §103(a) as unpatentable over Coteet; and Claims 3, 8, 12, and 13 were rejected under 35 U.S.C. §103(a) as unpatentable over Coteet in view of Sager et al. (U.S. Patent No. 4,342,084, hereinafter "Sager");.

With regard to the objection to Claims 3, 9-11, 13-15, and 17, Claim 3 is amended to recite "a compressed test result which fails to match." Claims 5, 9-11, 13, and 14 are amended to delete "first" and "second" designations. Claim 15 is amended to replace "configuredto" with "configured to." Finally, Claim 17 is believed to include appropriate punctuation as the element "the register selection circuit comprises a first shift counter which selects each of the registers" is followed by a semicolon. Accordingly, the objection to Claims 3, 9-11, 13-15, and 17 is believed to be overcome.

With regard to the rejection of Claims 1-18 under 35 U.S.C. §112, second paragraph, the pending claims are amended to change all references to "in a first order," "in a second order," "in a third order," and "in a fourth order" to "in order." Claim 1 is amended to recite "to compare the resulting compressed test result signatures with the scan chains." With

respect to Claim 7, it is respectfully submitted that the "block compression unit" recited in Claim 7 is not the same as the "test compression unit" recited in Claim 1. For example, Figure 4 shows a non-limiting embodiment including block compression unit 3 and collective compression unit 16. Thus, it is respectfully submitted that not all compression units should be treated as the same, as asserted in the outstanding Office Action at page 5, lines 19-21. Finally, Claims 12, 13, and 16 are amended to provide antecedent basis for all terms. Accordingly, Claims 1-18 are in compliance with all requirements under 35 U.S.C. §112, second paragraph.

With regard to the provisional non-statutory double patenting rejection of Claims 1-5 in view Claim 4 of U.S. Patent Application No. 10/426,657, that rejection is respectfully traversed in light of the terminal disclaimer submitted herewith.

The filing of a terminal disclaimer to obviate a rejection based on non-statutory double patenting is not an admission of the propriety of the rejection. The "filing of a terminal disclaimer simply serves the statutory function of removing the rejection of double patenting, and raises neither a presumption nor estoppel on the merits of the rejection." *Quad Environmental Technologies Corp. v. Union Sanitary District*, 946 F.2d 870, 20 USPQ2d 1392 (Fed. Cir. 1991). Accordingly, Applicants filing of the attached disclaimer is provided for facilitating a timely resolution to prosecution only, and should not be interpreted as an admission as to the merits of the obviated rejection.

With regard to the rejection of Claim 1 as anticipated by Coteet, that rejection is respectfully traversed.

Amended Claim 1 recites in part:

a test result compression unit connected to the output stages of the scan chains, configured to compress the test results so as to generate the same number of compressed test result signatures as the number of the test results, to compare the resulting compressed test result signatures with the scan chains, and to detect the scan chain which fails to match the

compressed test result signature corresponding to each scan chain.

The outstanding Office Action cited three portions of Coteet as describing “a test result compression unit” as defined in original Claim 1. The first portion, column 1, lines 20-26 of Coteet, describes the background art and how it is inferior to the device described by Coteet. It is respectfully submitted that this general description of background art does not teach the test result compression unit as defined in amended Claim 1. The last two portions, column 3, lines 46-60 and column 4, lines 12-16 of Coteet, describe the device of Coteet, but do not describe any compression of test results. In fact, it is respectfully submitted that no portion of Coteet describes “a test result compression unit connected to the output stages of the scan chains, configured to compress the test results so as to generate the same number of compressed test result signatures as the number of the test results, to compare the resulting compressed test result signatures with the scan chains, and *to detect the scan chain which fails to match the compressed test result signature corresponding to each scan chain*” as defined in amended Claim 1. Therefore, Claim 1 (and Claims 2-18 dependent therefrom) is not anticipated by Coteet and is patentable thereover.

With regard to the rejection of Claims 3, 8, 12, and 13 as unpatentable over Coteet in view of Sager, it is noted that Claims 3, 8, 12, and 13 are dependent from Claim 1, and thus are believed to be patentable for at least the reasons discussed above. Further, it is respectfully submitted that Sager does not cure any of the above-noted deficiencies of Coteet. Accordingly, it is respectfully submitted that Claims 3, 8, 12, and 13 are patentable over Coteet in view of Sager.

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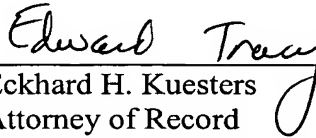
Reply to Office Action of September 13, 2006

Consequently, in view of the present amendment, no further issues are believed to be outstanding and the present application is believed to be in condition for formal allowance.

An early and favorable action to that effect is respectfully requested.

Respectfully submitted,

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